

REMARKS

In the last Office Action, claims 1-10 were allowed and claims 11-20 were objected to because of alleged informalities in claim 11 and because of an informality in claim 14. Acknowledgement was made of applicants' claim for foreign priority under 35 U.S.C. §119, and the Examiner acknowledged receipt of the certified copy of the priority application thereby perfecting the foreign priority claim. The drawings including the replacement drawing sheet submitted with the last response have been accepted by the Examiner.

Prosecution on the merits has been closed in accordance with the practice established under Ex parte Quayle.

Applicants and applicants' attorney acknowledge with appreciation the allowance of claims 1-10 and the indication of allowability concerning claims 11-20.

In accordance with this response, claim 14 has been amended in the manner suggested by the Examiner to overcome the objection. A new abstract not exceeding 150 words has been submitted to replace the previous abstract.

Concerning the objection to claim 11, applicants respectfully traverse the objection and request reconsideration and withdrawal thereof. The Examiner has objected to the recitations "means defining an arcuate

groove..." and "means defining a high pressure supplying hole..." since no function is specified by the words preceding the word "means". In support of the objection, the Examiner cited Ex parte Klumb, 159 USPQ 694 (Bd. App. 1967).

It is not clear whether the Examiner is objecting to these recitations because the word "means" is not preceded by functional language, such an objection is not understood. There is no requirement, either in the statute or case law, that a "means" clause must be preceded by a functional statement. In the Klumb case, the Board sustained an indefiniteness rejection under 35 U.S.C. §112 because the claim recitations "plate means" and "wing means", in and of themselves and without specifying any function for the "means", rendered the claim indefinite. The Board noted that "wing means" had the same meaning as "means for winging" and that "plate means" had the same meaning as "means for plating", neither of which were pertinent to, nor had any meaning with respect to, the disclosure.

The Klumb case did not state, and does not stand for the proposition, that a "means" recitation must be preceded by a functional modifier. To the contrary, 35 U.S.C. §112, sixth paragraph, states that an element in a claim may be expressed as "means" or a step for performing a specified function without the recital of structure, material, or acts in support thereof." Thus Section 112 permits the claiming of an element

as a means for performing a specified function, such as appears in claim 11.

In claim 11, the structure of the "means defining an arcuate groove" is that structure which defines an arcuate groove configured and arranged to communicate with bottom portions of the vane grooves during intaking and compression of the gas in the compression chambers. The structure of the "means defining a high pressure supplying hole" is that structure which defines a high pressure supplying hole configured and arranged to communicate with the bottom portions of the vane grooves during end stage compression of the gas compression chambers at times when the bottom portions of the vane grooves are not in communication with the arcuate groove. In both cases, the function of the "means" is specified in the wording beginning with "defining." The words "means defining..." can be read as "means for defining..." and both have the same meaning.

Further, there is no requirement that applicants invoke the means-plus-function provision of 35 U.S.C. §112, sixth paragraph in order to particularly point out and distinctly claim the subject matter of the invention. As presently worded and without invoking 35 U.S.C. §112, sixth paragraph, claim 11 is definite and the scope of the claim can be reasonably determined. As presently worded, the two "means defining..." recitations simply recite the structure necessary

to define an arcuate groove and a high pressure supplying hole configured and arranged as stated in the claim.

Lastly, it is common practice to define openings, holes, grooves and the like as means defining an opening, hole or groove. This manner of claiming avoids reciting an opening, hole or groove as a structural element when, in fact, such are spaces defined by their surrounding structure. See, for example, U.S. Patent No. 4,867,658 which is of record herein and which includes the recitations "means defining a gas inlet opening," and "means defining a gas outlet opening" (claim 1); "means defining grooves" and "means defining throughbores" (claim 2) and "means defining a set of grooves" and "means defining at least one throughbore" (claim 3). This manner of claiming is notoriously commonplace and conventional.

For the foregoing reasons, applicants respectfully request withdrawal of the objection to the "means defining" recitations in claim 11.

In view of the foregoing, the application is now believed to be in allowable form, accordingly, favorable reconsideration and passage of the application to issue are respectfully requested.

Respectfully submitted,

ADAMS & WILKS
Attorneys for Applicants

By: 

Bruce L. Adams
Reg. No. 25,386

50 Broadway
31st Floor
New York, NY 10004
(212) 809-3700

MAILING CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: MS NON-FEE AMENDMENT, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Debra Buonincontri

Name

Debra Buonincontri

Signature

March 28, 2005

Date